

### REMARKS

Claims 1 – 38 are pending in this application; Claims 1, 2, 4, 5, 8, 9, 10 – 18, 34, 37 and 38 have been amended in several particulars to overcome the §112 rejection.

Claims 23 – 33 have been allowed over the prior art of record without the necessity for amendments.

Drawings stand objected because FIG. 3 was not labeled as "Prior Art". The requirement set forth in Paragraph 1 of Paper No. 12 is traversed. There is no requirement set forth in §608.02(g) of the *Manual of Patent Examining Procedure* mandating the labeling of Figure 3 as "Prior Art". 35 U.S.C. §103 defines prior art by reference to §102. Figure 3 does not itself constitute "Prior Art" as defined by §102. Furthermore, Figure 3 is an abstract representation devised by Applicant in order for Applicant to explain the deficiencies in the "Prior Art"; as such, Figure 3 itself does not constitute "Prior Art". The requirement is thus improper; its drawl is requested.

The specification was objected to for containing numerous grammatically and typographical errors. The Examiner requires a substitute specification because Applicant's amendments to the specification filed on 8 January 1993 rendered the originally filed specification difficult to read. Accordingly, a substitute specification for the originally filed

specification is hereby submitted with cross-reference to related applications claimed under 35 USC §119. Applicant's undersigned attorney hereby declares that the substitute specification contains no new matter over that contained in the originally filed specification under 37 CFR §1.125.

The Abstract of the disclosure was objected because of the usage of the term "means". Accordingly, the abstract has been amended as is presented in the substitute specification to overcome this objection.

The disclosure was objected because the description of FIGs. 1-3 regarding the conventional color video printer should be discussed in the "background of the invention" as is specified by MPEP §608.01(d). This objection is respectfully traversed as follows.

First, no rule under 37 CFR requires Applicant to specifically describe the detailed problems of the conventional color video printer in the "background of the invention" section. In fact, 37 CFR §1.77 simply requires an application to arrange in the order of: (a) Title of invention; (b) [Reserved]; (c) Cross-reference to related applications; (d) brief summary of the invention; (e) Brief description of the ... drawings, if there are drawings; (f) Detailed description. Detailed description is defined under 37 CFR §1.171(a) as:

"a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or

discovery appertains, or with which it most nearly connected, to make and use the same."

The description of detailed problems of the conventional color video printer is nothing more than a written description of the **discovery** of the source of the problems in the art, and is often in itself the invention. As is well known in patent practice, the solution to a problem, once known, may often be obvious even when the recognition of the problem itself or of the source of the problem is not. A patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. See *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 US 45 (1923); *In re Peehs*, 612 F.2d 1287, 204 USPQ 835 (CCPA 1980). For this reason, the detailed problems of the conventional color video printer should be appropriately described in the detailed description of the invention, rather than the "background of the invention" as is asserted by the Examiner.

Second, although MPEP §608.01(d) does prefer Applicant to describe the detailed problems of the prior art in the "background of the invention" section, Applicant is not mandated to follow the preference of MPEP. As a matter of law, the MPEP in itself, as is expressly stated in its Foreword, does not have the force of law or the force of the Patent Rules of Practice (37 CFR). The MPEP is simply a looseleaf training and instruction manual for examiners which is continually revised in piecemeal fashion and it is not surprising to find inconsistencies in it. See *Racing Strollers Inc. v. TRI Industries Inc.* 11 USPQ2d 1300 (CAFC 1989).

Accordingly, in view of the above reasons and the fact that all pending claims are in condition to be passed to issuance, Applicant respectfully requests the Examiner to withdraw this objection and pass the application to issuance without further examination on the merits.

Claims 1 – 22 and 34 – 38 stand rejected under 35 U.S.C. §112, **second** paragraph, as being indefinite in a number of instances. Accordingly, claims 1, 2, 4, 5, 8, 9, 10 – 18, 34, 37 and 38 have been amended in those instances as kindly suggested by the Examiner in order to obviate this rejection.

Specifically, in claim 1, the Examiner asserted that the phrase "the occurrence" lacks antecedent basis. Actually, this phrase is a surplusage, and accordingly has been deleted to render the rejection moot.

In claim 2, the word "of" is also a surplusage and has accordingly been deleted to render the rejection moot as well. In addition, claim 2 has also been amended to provide proper antecedent basis for the "second data" and the "successive field periods."

In claim 9, the Examiner asserted that the "means for storing ... reading ..., accommodating ..., applying ..., and enabling ... is indefinite because it does not have sufficient structure to support the functions. Actually, this means is a data converter 60 and its peripheral circuits shown in FIGs. 4, 5 and 6 as comprising a plurality of circuit elements which are used

to store, read and apply columns of color video data for printing and displaying on a monitor. In all events, however, claim 9 has been amended to solely describe the functions of storing, reading for subsequent printing and applying for subsequent displaying. The term "accommodating" which was found to be indefinite has been deleted to render the rejection moot.

In claim 10, the Examiner asserted that the phrases "said recording address generating means" and "said printing address generating means" lack proper antecedent basis. These phrases have been deleted to obviate the rejection and avoid potential issues of ambiguities.

In addition to these claims, claims 2, 5, 8 have also been amended to provide proper antecedent basis for the "second data," the "video raster scan." Accordingly, in view of the foregoing amendments, Applicant respectfully requests that the rejection be withdrawn.

Claims 10 - 22 were also rejected under 35 U.S.C. §112, second paragraph, as being "incomplete for omitting essential structural cooperative relationships of elements." Specifically, the Examiner asserted that "it is not clear [in claim 10] where the printing signal is coming from, or what element is doing the printing in response to the printing signal," and that there is no cooperation "between the first, second, and third selection signals, the mode signal, and the color video printer" in claim 17 and "between the recording mode, printing mode, and monitoring mode

signals, and the color video signals." Accordingly, claims 17 and 18 have been amended to include "control means" for providing functional relations between the printer and these various signals as is kindly suggested by the Examiner. Similarly, claim 10, claim 10 has been amended to include an essential printing means for printing color video data stored in the line memory so as to avoid this rejection. For these reasons, Applicant also respectfully requests that the rejection be withdrawn.

Additionally, Applicant also takes the opportunity to amend claims 11 – 16, 34, 37 and 38 to provide proper antecedent basis for the "display means" and "data conversion means" as well as to avoid potential issues of ambiguities.

In summary, in view of the foregoing amendment to these claims, Applicant believes that all pending claims 1 – 38 are now in condition to be passed to issuance.

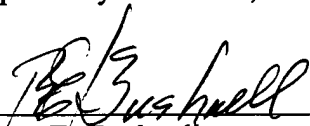
Entry of the foregoing amendments is proper under 37 C.F.R. §1.116(b) because those amendments simply respond to the issues raised in the final rejection, no new issues are raised, no further search is required, and the foregoing amendments are believed to remove the basis of the outstanding rejections and to place all claims in condition for allowance. The foregoing amendments, or explanations, could not have been made earlier because these issues had not previously been raised.

No fee is incurred by this response.

A Letter to the Office Draftsman accompanies this response. Indication in subsequent Office correspondence of the acceptance to the drawing corrections proposed in the Letter, is requested to enable Applicant to timely arrange for the corrections to be made prior to the date for payment of any issue fee.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,

  
\_\_\_\_\_  
Robert E. Bushnell,  
Attorney for the Applicant  
Registration No.: 27,774

Suite 425  
1511 "K" Street, N.W.  
Washington, D.C. 20005  
(202) 638-5740

Folio: P53521  
Date: 12/19/94  
I.D.: REB/HB/kf